

REMARKS/DISCUSSION:

This Response C is being within three months after the shortened statutory period for response that ended on September 21, 2006. Accordingly, a Petition for a Three-Month Extension of Time is made a part of the transmittal document filed herewith.

By this Response C, claims 1, 2, 4-13 and 15-22 remain pending in this application.

Amendment and/or cancellation of claims is not to be construed as a dedication to the public of any of the subject matter of the claims previously presented. Further, Applicant(s) reserves the right to prosecute the subject matter of such claims in continuation and/or divisional applications.

Applicant has carefully studied the outstanding Office Action. This Amendment is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of the application are respectfully requested.

Rejection under 35 U.S.C. § 103

Claims 1-2, 4-13, 15-22 stand rejected as being unpatentable over Hood in US Patent No. 5,935,143 in view of Alexander in US Patent No. 2,784,751 and in view of Okada et al. in US Patent No. 6,887,252 B1 as noted in the Office Action.

In particular, the Examiner states that Hood teaches a laminated ultrasonic waveguide (page 2, last paragraph). Applicant is unable to find any statement or suggestion in Hood that discloses a laminated ultrasonic waveguide. Therefore, Applicant respectfully disagrees with the Examiner's assertion that Hood teaches a laminated waveguide.

Under MPEP 2143, in order to establish a *prima facie* case of obviousness, the prior art reference or combination of references must teach or suggest all of the limitations of a claim. A *prima facie* case of obviousness also requires that there be some teaching suggestion, or motivation to modify the references either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143.01. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

In view of the foregoing requirements for a *prima facie* case of obviousness, Applicant submits that the combined art of record fails to render the claims obvious. In particular, Applicant notes that the combination of references fails to teach or suggest all of the limitations of each claim in accordance with MPEP 2143.03. In addition, Applicant submits that even if the combined art of record taught or suggested all of the limitations of each present independent claim, there is no teaching, suggestion, or motivation to modify or combine the references to obtain the invention presently claimed, such that a *prima facie* case of obviousness has not been, and cannot be, established in accordance with MPEP 2143.01.

Furthermore, even if the combined art of record taught or suggested all of the elements of any of the independent claims, the art is devoid of any suggestion or motivation to modify or combine the teachings of the references in order to obtain the claimed invention. Indeed, MPEP 2143.01 admonishes that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” (emphasis in original). *Actual evidence* of a suggestion, teaching, or motivation to combine prior art references must be shown. *In re Dembiczack*, 50 USPQ2d 1614 (Fed. Cir. 1999). It is also well settled that an “obvious to try” rationale is insufficient to satisfy the Office’s burden under MPEP 2143.01.

In formulating the pending §103 rejections, the Office has failed to articulate any motivation whatsoever to combine or modify the teachings of the references in order to obtain the invention presently claimed. Instead, the Office has merely cobbled together random teachings of the prior art in order to allegedly find the subject matter of limitations recited in the present claims. Upon completion of such cobbling, the Office simply concludes “Therefore, it would have been obvious,” without any further explanation. At most, this amounts to nothing more than an “obvious to try” rationale, which is clearly unacceptable under MPEP 2145. Again, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In addition to failing to articulate any rationale to establish the motivation required by MPEP 2143.01, the Office has failed to provide any evidence to support such a rationale. In short, without any rationale on motivation to combine/modify, and without any actual evidence to support the same, the Office has fallen far short of its burden under MPEP 2143.01. Because the motivation element of a *prima facie* obviousness case required by MPEP 2143.01 is lacking, Applicant respectfully requests that the rejections be withdrawn.

Beyond the foregoing shortcomings with respect to the rejections of the independent claims, Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for novelty and non-obviousness.

For instance, Applicant submits that the combined art of record fails to teach or suggest all of the limitations recited in claims 8, 9, 19 and 20. In particular, the combined art of record fails to teach or suggest, among other things, a first and third outer laminated pieces of sheet stock extend from the proximal end of the ultrasonic end effector for a portion of the length of the ultrasonic end effector or the second inner laminated piece of sheet stock extends to a distal active tip end

of the laminated ultrasonic end effector (claims 8 and 9, respectively). The Examiner states that Alexander makes such a disclosure as seen in figure 2 (page 4 in the Office Action). Figure 2 makes no such disclosure or suggestion. Fig. 2 illustrates 3 blade portions, as is indicated by the partially broken away views. Fig. 2 cannot be interpreted to show relative sizes of the blades as relied upon by the Examiner. Accordingly, and at a minimum, the combined art of record fails to render claims 8, 9, 19 and 20 obvious in accordance with MPEP 2143.03. Applicant therefore respectfully requests that the rejections be withdrawn.

While Applicant has noted several distinctions over the art of record, Applicant notes that several other distinctions exist, and Applicant preserves all rights and arguments with respect to such distinctions.

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Conclusion

Applicant submits that in view of the discussion, the rejection under 35 U.S.C. § 103 has been overcome and that the invention is now patentable over the cited prior. The Examiner is respectfully requested to reconsider all rejections and pass this case to issue.

Should any minor points remain prior to issuance of a Notice of Allowance, the Examiner is requested to telephone the undersigned at the below-listed telephone number.

The Commissioner is hereby authorized to charge any additional fees which may be required to Account No. 10-0750/END0701/VEK.

Respectfully submitted,

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